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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,685	01/04/2001	John B. Ferber	08011.3000-00000	1659
22852	7590	06/21/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/753,685

Applicant(s)

FERBER, JOHN B.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26, 28-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

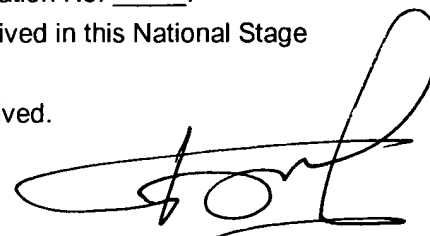
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



IGOR N. BORISSOV  
PRIMARY EXAMINER

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 4/11/2006 is acknowledged and entered. Claims 27 and 34 have previously been canceled. Claims 1-26, 28-33 and 35-37 are currently pending in the application.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 22, 23, 25, 26, 28-30, 32, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (US 6,381,465) in view of Angles et al. (US 5,933,811).**

#### Independent Claims

**Claim 22.** Chern et al. (Chern) teaches a method for transmitting advertisements to a wireless device, comprising:

identifying a location of the wireless device registered with a wireless advertising service (C. 8, L. 54-57);

providing advertising messages to the wireless advertising service (server) (C. 11, L. 9-20; C. 12, L. 16-19);

re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and

sending said advertisement messages from the wireless advertising service (server) to the wireless device (C. 11, L. 21-24),

wherein said advertisement message is based upon the identified location of the wireless device (C. 13, L. 43-50).

Furthermore, Chern teaches that the user receives said messages on a subscription basis (Fig. 12, item 692), thereby suggesting paying a fee to the wireless advertisement service for the services rendered.

Chern does not specifically teach *remunerating users once the user has accepted a predetermined number of the advertising messages*. Also, Chern does not specifically teach that *a portion of the fee paid for said advertising service goes to the user*.

Angles et al. (Angles) teaches a method for delivering customized advertisements within interactive communication environment, including: *paying a fee to an Internet provider (wireless advertising service) based on number (predetermined) of advertisements viewed* (C. 16, L. 31-33); *paying registered users for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37, 40-41); wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61); and wherein *a portion of advertising revenue goes to the user as reduced access fee* (C. 4, L. 45-47), and further wherein

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include *remunerating users for accepting the advertising messages*, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include that *a portion of advertising revenue goes to the user*, as disclosed in Angles, because it would advantageously allow an Internet provider to reduce consumer access fees, as specifically stated in Angles (C. 4, L. 45-47).

**Claim 29.** Chern teaches said method for transmitting advertisements to a wireless device, comprising:

identifying a location of the wireless device registered with a wireless advertising service (C. 8, L. 54-57);

re-formatting advertising messages at the wireless advertising service (server) into a format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and

sending said advertisement message to the wireless device (C. 11, L. 21-24); wherein said advertisement message is based upon the identified location of the wireless device (C. 13, L. 43-50).

Chern does not specifically teach *remunerating users once the user has accepted a predetermined number of the advertising messages*.

Angles teaches said method and system for delivering customized advertisements within interactive communication environment, wherein *registered users are paid for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37), and wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include *remunerating users for accepting the advertising messages*, as disclosed in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

#### Dependent Claims

**Claims 23 and 30.** Chern teaches said method, wherein said advertising messages are text messages (Fig. 16).

**Claims 25 and 32.** Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claims 26 and 33.** Chern teaches said method, wherein said advertising message is a coupon (C. 1, L. 13).

**Claims 28 and 35.** Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (US 6,381,465) in view of Lee et al. (US 6,829,475) and further in view of Angles et al. (US 5,933,811).**

*Independent Claims*

**Claims 1 and 11.** Chern teaches a method and system for transmitting advertisements to wireless devices, said system including an Internet provider server and advertisement server; said method comprising:

receiving user information (receiving registration information) stored in the memory of the wireless device, said information related to the user, user's preferences and the wireless device (C. 8, L. 37-41);

identifying a location of the wireless device (C. 8, L. 54-57); receiving advertising messages from advertisers (C. 11, L. 9-20; C. 12, L. 16-19);

re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and

sending said advertisement message to the wireless device (C. 11, L. 21-24), wherein said advertisement message is based upon the identified location of the wireless device (C. 13, L. 43-50).

While Chern does teach receiving user information including information regarding the wireless device (C. 8, L. 37-41), and thereby indicating prior registering step, Chern does not explicitly teach said registering step, said registering step including *receiving a wireless device number that is input by a user from a website*.

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Also, Chern does not specifically teach *remunerating users once the user has accepted a predetermined number of the advertising messages*.

Lee at al. (Lee) teaches a method and system for transmitting advertising messages to wireless devices, wherein prior to receiving said advertising messages, a user has to register his/her wireless device; said registering step including *logging into the Internet gateway network (indicates accessing a registration website) and inputting information about user's wireless device, including identification number, model, etc.* (C. 14, L. 1-6).

Angles teaches said method and system for delivering customized advertisements within interactive communication environment, including *paying registered users for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include said registering step, wherein said registering step including *receiving a wireless device number that is input by a user from a website*, as disclosed in Lee, because it would advantageously allow users to choose the desired formats and individual stations from which the user prefer to receive said messages while still being logged on to said website, as specifically stated in Lee (C. 14, L. 18-24).

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Lee to include *remunerating users once the user has accepted a predetermined number of the advertising messages*, as indicated in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 17.** Chern teaches said method for transmitting advertisements to wireless devices, comprising:

providing a server and database for storing the retrieved "user information", said information related to the user, user's preferences and registered wireless device (C. 8, L. 37-41; 44-45);

receiving advertising messages from advertisers over the network (C. 11, L. 9-20; C. 12, L. 16-19);

re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33);

identifying a location of the wireless device (C. 8, L. 54-57); and sending said advertisement message to the wireless device (C. 11, L. 21-24),

wherein said advertisement message is based upon the identified location of the handset and said "user information" (C. 13, L. 43-50).

While Chern does teach receiving user information including information regarding the wireless device (C. 8, L. 37-41), and thereby indicating prior registering step, Chern does not explicitly teach that said information includes *a wireless device number*. Also, Chern does not specifically teach *remunerating users once the user has accepted a predetermined number of the advertising messages*.

Lee teaches said method for transmitting advertising messages to wireless devices, wherein prior to receiving said advertising messages, a user has to register his wireless device; said registering step including *logging into the Internet gateway network (indicates accessing a registration website) and inputting information about wireless device, including identification number, model, etc.* (C. 14, L. 1-6).

Angles teaches said method for delivering customized advertisements within interactive communication environment, including *remunerating users once the user has accepted a predetermined number of the advertising messages* (C. 16, L. 35-37), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include that said information includes *a wireless device number*, as disclosed in Lee, because it would advantageously allow users to



associate the desired formats and individual stations from which the user prefer to receive said messages with user's wireless device, as specifically stated in Lee (C. 14, L. 18-24).

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Lee to include *remunerating users once the user has accepted a predetermined number of the advertising messages*, as indicated in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Dependent Claims**

**Claims 2 and 16.** Angles teaches receiving payment from the advertisers for sending the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 5.** Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 8.** Angles teaches said method and system, wherein registering the wireless devices to receive advertising messages includes providing demographic information of a user of the wireless device (C. 3, L. 19-29). The motivation to combine Chern and Lee with Angles would be to potentially increase sales and revenue by providing users with advertising closely matching users interests.

**Claims 9 and 14.** Lee teaches said method and system, wherein advertising messages are stored in advertising (second) database (C. 11, L. 25-28). The motivation to combine Chern with Lee would be in response to user's request to look up additional information regarding requested product (Lee; C. 28-36).

**Claims 10 and 21.** Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to

combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

**Claim 13.** Lee teaches registering means (C. 14, L. 1-6). The motivation to combine Chern with Lee would be to stimulate users to receive individually tailored advertisement messages, thereby potentially increase sales and revenue.

**Claims 36 and 37.** Lee teaches said method and system, wherein said wireless device is a PDA (C. 7, L. 61-62); said PDA is adapted to display navigation services including maps (graphics) (C. 7, L. 15-16; C. 8, L. 9-10). The motivation to combine Chern with Lee would be to provide the user with most accurate navigation services so that the user would always have the updated information when highway changes occur (Lee; C. 8, L. 10-11).

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Atsmon et al. (US 6,607,136).**

*Dependent Claim*

**Claim 3.** Chern, Lee and Angles teach all the limitations of claim 3, including paying the users as a bonus for accepting said advertisement messages (Angles; C. 20, L. 32-35), except specifically teaching that said remunerating includes remunerating *points* for accepting said advertisement messages.

Atsmon et al. (Atsmon) teaches a method for interacting with a broadcast media (TV or PC) to receive coupons and sales special offers, wherein users receive incentive *points* as a reward for watching advertisement (C. 55, L. 31-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include awarding the users with incentive points as a reward for watching advertisement, as disclosed in Astmon, because it would advantageously stimulate users to spend more in order to achieve a reward, thereby potentially increase sales and revenue.

**Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Maxwell (US 6,470,181).**

*Dependent Claims*

**As per claims 4 and 19**, Chern, Lee and Angles teach all the limitations of Claims 4 and 19, except specifically teaching that said remunerated step includes providing additional air-time for accepting the advertising messages.

Maxwell teaches a method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement (C. 3, L. 10-12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include providing additional air-time for accepting the advertising messages, as disclosed in Maxwell, because it would advantageously allow low income users, such as students, to afford long distance calls.

**Claims 6, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Bezos et al. (US 6,029,141).**

*Dependent Claims*

**As per claims 6, 15 and 20**, Chern, Lee and Angles teach all the limitations of claims 6, 15 and 20, except that users receive remuneration for *referring* an unregistered user to receive advertising messages.

Bezos et al. (Bezos) teaches a method and system for an Internet-based customer referral system, wherein registered users receive commissions for referring other users to merchant's site (C. 1, L. 62 – C. 2, L. 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include that users receive

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remuneration for referring an unregistered user to receive advertising messages, as disclosed in Bezos, because it would advantageously allow advertisers to expose their products to larger audience, thereby increase revenue.

**Claims 7, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Matsumoto et al. (US 6,484,946).**

Dependent Claims

**As per Claims 7, 12 and 18**, Chern, Lee and Angles teach all the limitations of claims 7, 12 and 18, including that a user account for each registered wireless device is credited for accepting advertising messages (Angles; C. 21, L. 19-24), except specifically teaching that said user account is a *user accessible* account.

Matsumoto et al. (Matsumoto) teaches a method for accessing and displaying information related to electronic money transaction, wherein a user is able to accesses his account to review confidential information, including points accumulated and redeemed at participating merchants (C. 12, L. 11-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include that said user account is a *user accessible* account, as disclosed in Matsumoto, because it would advantageously allow the user to avoid termination of his service for non payment.

**Claim 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Angles and further in view of Maxwell.**

Dependent Claims

**As per Claims 24 and 31**, Chern and Angles teach all the limitations of Claims 24 and 31, except specifically teaching that said remunerated step includes providing additional air-time for accepting the advertising messages.

Maxwell teaches said method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement (C. 3, L. 10-12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include providing additional air-time for accepting the advertising messages, as disclosed in Maxwell, because it would advantageously allow low income users, such as students, to afford long distance calls.

### ***Response to Arguments***

Applicant's arguments filed 4/11/2006 have been fully considered but they are not persuasive.

In response to applicant argument that Angles fails to teach *paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined number of advertising messages sent to the registered wireless device*, it is noted that Chern teaches a wireless advertising service, which transmits advertisements to its customers on a subscription basis (Fig. 12, item 692), thereby suggesting paying a fee to the wireless advertisement service for the services rendered. Angles teaches a method for delivering customized advertisements within interactive communication environment, including: *paying a fee to an Internet provider (wireless advertising service) based on number (predetermined) of advertisements viewed* (C. 16, L. 31-33); *paying registered users for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37, 40-41); said paying further includes *allocating a portion of advertising revenue to the user as reduced access fee* (C. 4, L. 45-47).

In response to applicant argument that Lee fails to teach *paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined number of advertising messages sent to the registered wireless device*, it is noted that Chern in view of Angles disclose this feature. Lee was applied to show *receiving a wireless device number that is input by a user from a website* (C. 14, L. 1-6). At this point Examiner stipulates that applicant argues against the references individually; however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant argument that Atsmon fails to teach *paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined number of advertising messages sent to the registered wireless device*, it is noted that Chern in view of Angles disclose this feature. Atsmon was applied to show that said remunerating includes *remunerating points for accepting said advertisement messages* (C. 55, L. 31-34). At this point Examiner stipulates that applicant argues against the references individually; however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Same reasoning applied to applicant's arguments that Maxwell, Bezoz and Matsumoto does not disclose the above-discussed feature.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

6/13/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a large, stylized flourish extending from the end of the signature.

**IGOR N. BORISSOV  
PRIMARY EXAMINER**